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TRANSMITTAL LETTER  
(General - Patent Pending)

Docket No.

41766-1

In Re Application Of: Alfred C. Nichols, et al.

Serial No.  
09/625,018

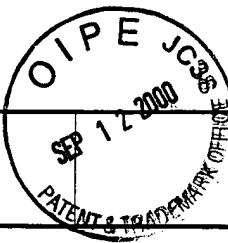
Filing Date  
7/20/00

00117200  
TECH CENTER 1600/2900

Examiner  
Unknown

Group Art Unit  
1625

Title: QUINOLIC ACID DERIVATIVES



TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is:

- Request for Corrected Filing Receipt
- Response to Notice to File Missing Parts
- Reissue Application Declaration by the Inventor
- Verified Statement Claiming Small Entity Status

in the above identified application.

- No additional fee is required.
- A check in the amount of \$65.00 is attached.
- The Assistant Commissioner is hereby authorized to charge and credit Deposit Account No. 501346 as described below. A duplicate copy of this sheet is enclosed.
  - Charge the amount of
  - Credit any overpayment.
  - Charge any additional fee required.

Signature

Kenneth M. Bush, Reg. No. 40,544  
SIROTE & PERMUTT, P.C.  
P.O. Box 55727  
Birmingham, AL 35255-5727  
Phone: (205) 930-5383  
Facsimile: (205) 930-5101

Dated: 9-12-00

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20 OCT 19 AM 11:13

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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I certify that this document and fee is being deposited on [redacted] with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**

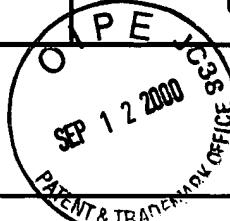
Applicant(s): Alfred C. Nichols, et al.

Docket No.

41766-1

Serial No.  
09/625,018Filing Date  
7/20/00Examiner  
UnknownGroup Art Unit  
1625

Invention: QUINOLIC ACID DERIVATIVES



I hereby certify that this Request for Corrected Filing Receipt and attachments  
(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under  
37 CFR 1.10 in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C.

20231-0001 on 9-12-00  
(Date)Donita King

(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

EK666547102US

("Express Mail" Mailing Label Number)

**Note: Each paper must have its own certificate of mailing.**

SIROTE  
— & —  
PERMUTT  
A PROFESSIONAL CORPORATION

KENNETH M. BUSH

ATTORNEY AT LAW

205.930.5383

*kbus@sirote.com*

*Registered United States Patent and Trademark Office*

September 12, 2000

**VIA EXPRESS MAIL**

Judge Fred McKelvey  
Box Interference  
Commissioner of Patents and Trademarks  
Washington, DC 20231

Re: Interference No. 104,522  
Nichols' Reissue Application documents

Dear Judge McKelvey:

On July 20, 2000, Junior Party Nichols filed a reissue application for U.S. Patent No. 5,783,700 involved in the above-referenced interference. Enclosed are additional documents relating to that reissue application that Nichols filed today. Copies of these documents are being served upon counsel for Senior Party Tabakoff with a copy of this letter.

Very truly yours,



Kenneth M. Bush  
FOR THE FIRM

KMB/dk

cc: Talivaldis Cepuritis

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AND INTERFERENCES

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POST OFFICE BOX 55727 BIRMINGHAM, ALABAMA 35255-5727

TELEPHONE | 205.930.5100 FAX | 205.930.5101 URL | <http://www.sirote.com>

Birmingham | Huntsville | Mobile | Montgomery

## CERTIFICATE OF SERVICE

I, Kenneth M. Bush, do hereby certify that a copies of the documents titled "REISSUE APPLICATION DOCUMENTS", was served by Express Mail number EK666547093US on this the 12<sup>th</sup> day of September, 2000, on the following counsel of record:

Attorneys for Tabakoff:

Talivaldis Cepuritis, Esquire  
OLSON & HIERL  
20 North Wacker Drive  
36<sup>th</sup> Floor  
Chicago, IL 60606

  
Kenneth M. Bush  
Attorney for Junior Party  
Registration Number 40,544  
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Facsimile: (205) 930-5101

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## CERTIFICATE OF MAILING

I, Kenneth M. Bush, do hereby certify that two copies of the document titled "REISSUE APPLICATION DOCUMENTS", were filed by Express Mail number EK153510414US on this the 12<sup>th</sup> day of September, 2000, addressed to:

BOX INTERFERENCE  
Commissioner of Patents and Trademarks  
Washington, DC 20231

  
Kenneth M. Bush  
Attorney for Junior Party  
Registration Number 40,544  
SIROTE & PERMUTT  
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Birmingham, AL 35255-5727  
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FILING RECEIPT



\*OC00000005319040\*



09-13-00

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76

SAC/AMM  
4300 ✓UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: ASSISTANT SECRETARY AND  
COMMISSIONER OF PATENT AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/625,018	07/24/2000	1625	690	41766	-	15	RECEIVED

Kenneth M Bush Esq  
Sirote & Permutt PC  
PO Box 55727  
Birmingham, AL 35255-5727

↳ should be 7/20/00

OCT 17 2000

TECH CENTER 1600/2900

Date Mailed: 08/14/2000

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Alfred C. Nicholas, Residence Not Provided;

↳ should be  
Alfred C. Nichols, Auburn, AL;  
K Lemone Yielding, Tuscaloosa, AL

## Continuing Data as Claimed by Applicant

THIS APPLICATION IS A REI OF 08/887,627 07/03/1997 PAT 5,783,700

## Foreign Applications

If Required, Foreign Filing License Granted 08/11/2000

## Title

Quinolic acid derivatives

## Preliminary Class

546

Data entry by : BATES, DIANA

Team : OIPE

Date: 08/14/2000



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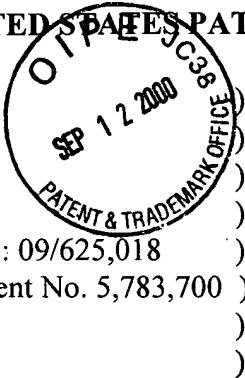
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of

Alfred C. Nichols, et al.

Non-Provisional Serial No.: 09/625,018  
Reissue Application of Patent No. 5,783,700

Filed: July 20, 2000



Examiner: Unknown

Group Art Unit: 1625

For: QUINOLIC ACID DERIVATIVES

Assistant Commissioner for Patents  
BOX MISSING PARTS  
Washington, D.C. 20231

Sirote & Permutt, P.C.  
P.O. Box 55727  
Birmingham, Alabama 35255

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**REQUEST FOR CORRECTED FILING RECEIPT**

Sir:

Applicants request that the United States Patent and Trademark Office ("Office") correct the filing date, and name of applicant of the above-referenced filing receipt. The filing date should be July 20, 2000. The name of the applicants should read Alfred C. Nichols, Auburn, Alabama, and K. Lemone Yielding, Tuscumbia, Alabama. Applicants also request the Office to issue a corrected filing receipt. A copy of the Filing Receipt indicating the above-noted changes is being submitted herewith.

This request for Corrected Filing Receipt is being submitted along with the Response to the Notice to File Missing Parts as requested on the face of the Filing Receipt dated August 14, 2000.

The present application is a reissue application of U.S. Patent No. 5,783,700. The inventors' names should be the same as identified in that patent, as shown by the Declaration being filed concurrently with the Response to the Notice to File Missing Parts.

The filing date for this application should be July 20, 2000. As shown by the certificate of mailing, this application was mailed via U.S. Express Mail on July 20, 2000. Pursuant to a June 9, 2000 Order by the Board of Patent Appeals and Interferences (a copy of which is attached) this reissue application was filed directly with the Board rather than the Patent Office. *See* attached Order, p.3. Therefore, the application should be given the date of deposit with the United States Postal Service rather than the date that the Board of Patent Appeals and Interferences delivered the application to the Patent and Trademark Office. 37 C.F.R. § 1.10 (a)

Please contact the undersigned if there are any questions regarding this request.

Respectfully submitted,

SIROTE & PERMUTT, P.C.

By:

  
Kenneth M. Bush  
Registration No. 40,544  
(205) 930-5383

OCT 1 7 2000

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TECH CENTER 1000

I, Kenneth M. Bush, do hereby certify that the enclosed "REISSUE APPLICATION" for Patent No. 5,783,700, was filed by Express Mail number EK666547062US on this the 20<sup>th</sup> day of July, 2000,

addressed to:



Judge Fred E. McKelvey  
Board of Patent Appeals and Interferences  
Crystal Gateway 2, 10<sup>th</sup> Floor  
1225 Jefferson-Davis Highway  
Arlington, VA 22202

  
Kenneth M. Bush  
Attorney for Junior Party  
Registration Number 40,544  
SIROTE & PERMUTT, P.C.  
P.O. Box 55727  
Birmingham, AL 35255-5727  
Phone: (205) 930-5100  
Facsimile: (205) 930-5101

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OCT 1 2000

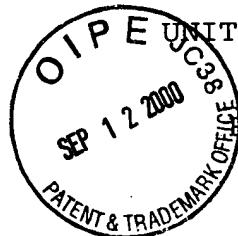
The opinion in support of the decision being  
entered today is not binding precedent of the Board.

TECH CENTER 1600/2900

Paper 20

Filed by: Fred E. McKelvey  
Senior Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Entered  
9 June 2000



UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

ALFRED C. NICHOLS and K. LEMONE YIELDING,

JUN 9 - 2000  
PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Junior Party,  
(Patent 5,783,700),

v.

BORIS TABAKOFF, LAWRENCE SNELL  
and PAULA L. HOFFMAN,

Senior Party  
(Application 09/171,697).

Patent Interference No. 104,522

ORDER  
FILING OF PRELIMINARY MOTIONS AND STATEMENTS

A. Conference call

A telephone conference call was held on 7 June 2000, at approximately 2:30 p.m. (1430 hours E.D.T.), involving:

1. Kenneth M. Bush, Esq., and Russell L. Sandidge, Esq., counsel for Nichols;
2. Talivaldis Cepuritis, Esq., counsel for Tabakoff;  
and

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20 OCT 19 2000  
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3. Fred E. McKelvey, Senior Administrative  
Patent Judge.

**B. Relevant discussion during conference call**

The principal purpose of the conference call was to set times for taking action during the preliminary motion phase of the interference.

1.

The Nichols list of proposed preliminary motions was reviewed.

Nichols proposed preliminary motions 1, 2, 3 and 4 in essence involve a charge of derivation. As represented during the conference call, the parties had some relation before the applications were filed. No attempt will be made to place on the record the nature of the relation because it is not clear that the board would accurately be able to articulate any relationship. Suffice it to say that the question of who invented what is more likely to come out during the priority testimony phase than through preliminary motions. Moreover, additional discovery (37 CFR § 1.687(c)) and testimony (37 CFR § 1.639(c)) in support of a preliminary motion is not likely to be authorized during the preliminary motion phase, but may be appropriate during the priority testimony phase of the interference.

Nichols proposed preliminary motions 5 and 6 may be filed together and should essentially raise the issue of whether particular patent claims should be designated as not

corresponding to the count. To prevail on the motion, Nichols should establish that the "particular" claims would be patentable over the subject matter of the Tabakoff claims which correspond to the count, assuming that subject matter to be prior art.

Nichols proposed preliminary motion 7 involves addition of a reissue application to the interference. Nichols should file the reissue application directly with the board (preferably by Federal Express addressed in the manner set out in ¶ 3(b) of the NOTICE DECLARING INTERFERENCE). The board will process the application through the Application Division. Failure to file the reissue application directly with the board may result in denial of any motion to add the reissue application to the interference.

Nichols proposed preliminary motion 9 should be made part of any motion to add a reissue application.

Nichols proposed preliminary motion 10 should be made part of Nichols proposed preliminary motion 8.

2.

Tabakoff proposes a preliminary motion for judgment based on (1) alleged lack of enablement (how to make) and (2) alleged failure to describe the best mode.

Tabakoff is ordered to file separate preliminary motions, one addressing enablement and the other addressing best mode.

3.

The parties are advised that in connection with issues involving derivation, inequitable conduct and failure to describe

a best mode the board often--but not always--elects to be present during cross-examination. Accordingly, cross-examination on these issues may be ordered to take place at the board in Arlington, Virginia. A decision on where cross-examination is to take place is generally made after reviewing the preliminary motion or following presentation of evidence on derivation.

**C. Time periods associated with preliminary motions**

In accordance with discussion during the conference call, and in accordance with times suggested by the parties, the following "Time Periods" as set out in an Appendix to this ORDER are established in this interference:

**1. TIME PERIOD 1**

The time for filing and serving preliminary motions (37 CFR § 1.636(a)) is set to expire at the end of TIME PERIOD 1.

If no party files a preliminary motion, the parties should place a conference call to the administrative patent judge so that a time for taking testimony or other appropriate action may be set.

Attention is directed to Paragraph 26(f) of the NOTICE DECLARING INTERFERENCE (Paper 1) if a request is made for leave to take testimony to support a preliminary motion.

Attention is directed to Paragraph 26(g) of the NOTICE DECLARING INTERFERENCE (Paper 1) with respect to any preliminary motion for judgment (37 CFR § 1.633(a)) based on inequitable conduct and/or fraud.

## **2. TIME PERIOD 2**

The time for filing and serving preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)) is set to expire at the end of TIME PERIOD 2.

## **3. TIME PERIOD 3**

The time for filing and serving oppositions to all preliminary motions, including preliminary motions filed pursuant to 37 CFR § 1.633(i) and (j), is set to expire at the end of TIME PERIOD 3.

## **4. TIME PERIOD 4**

The time for filing replies to all oppositions is set to expire at the end of TIME PERIOD 4.

## **5. TIME PERIOD 5**

The time for filing:

- a. if a party desires a hearing on preliminary motions, a request for a hearing;
- b. motions to suppress evidence relied upon by an opponent in connection with preliminary motions (compare 37 CFR § 1.656(h)); and
- c. observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 5.

## **6. TIME PERIOD 6**

The time for filing:

- a. oppositions to an opponent's motion to suppress and
- b. a response to observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 6.

## **7. TIME PERIOD 7**

The time for filing replies to oppositions to motions to suppress is set to expire at the end of TIME PERIOD 7.

The parties are authorized to stipulate different times (earlier or later, but not later than TIME PERIOD 7) for TIME PERIODS 1 through 6, provided, a notice is filed with the board as soon as practical after any agreement is reached. The notice should be in the form of a photostatic copy of the Appendix attached to this ORDER with old dates crossed out and new dates inserted by hand.<sup>1</sup> The parties may not stipulate an extension of TIME PERIOD 7.

---

<sup>1</sup> The purpose of this requirement is to make it easy for personnel at the board to determine the changes in dates agreed to by the parties.

**D. Deposition transcripts**

Transcripts of depositions of cross-examination and/or depositions taken under 35 U.S.C. § 24 shall be served, but not filed with the board until the exhibits are filed.

**E. Serving exhibits relied upon in preliminary motions**

An exhibit, including an affidavit, relied upon in connection with preliminary motions, oppositions, and replies shall be served (but not filed with the board) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned.

**F. Time for filing the record in connection with preliminary motions**

**TIME PERIOD 8**

On or before the expiration of TIME PERIOD 8,

1. An original and three copies of each exhibit, including affidavits, and deposition transcript should be filed with the board. Exhibits should be filed in an accordion folder, box or other folder containing all exhibits in numerical order (the copies of exhibits should be submitted in like fashion in an accordion type or other folders).

2. Three copies of preliminary motions, oppositions and replies previously filed should be filed with the board, with each copy of each motion, its opposition and its reply and any observations and any response to observations being filed in a separate folder.

3. Any ZIP® disk and/or CD-ROM which a party elects to file.

**G. Preliminary statements**

The time for filing (but not serving) preliminary statements (37 CFR § 1.621(a), see also 37 CFR § 1.627(a)) is the same as the time for complying with TIME PERIOD 1.

The time for filing the notice required by 37 CFR § 1.621(b) is the same as the time for complying with TIME PERIOD 1.

A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party. 37 CFR § 1.631(b). Without further order of the board, within one (1) week after the date for filing preliminary statements, a copy of a party's preliminary statement shall be served on each opponent who served a notice under 37 CFR § 1.621(b).

*MCK*

---

FRED E. MCKELVEY  
Senior Administrative Patent Judge

9 June 2000  
Arlington, VA

**Appendix**

**ORDER  
FILING OF PRELIMINARY MOTIONS AND STATEMENTS**

Interference 104,522

1. TIME PERIOD 1                           **30 August 2000**  
Filing preliminary motions
2. TIME PERIOD 2                           **13 September 2000**  
Filing Rule 633(i) and  
Rule 633(j) preliminary  
motions
3. TIME PERIOD 3                           **8 November 2000**  
Filing of oppositions to  
all preliminary motions
4. TIME PERIOD 4                           **20 December 2000**  
Filing of replies
5. TIME PERIOD 5                           **17 January 2001**  
Filing of request for  
hearing; motions to suppress  
and observations with  
respect to cross-examination
6. TIME PERIOD 6                           **31 January 2001**  
Filing of oppositions to  
motions to suppress and  
any response to observations  
with respect to cross-  
examination
7. TIME PERIOD 7                           **14 February 2001**  
Filing replies to  
oppositions to motions  
to suppress
8. TIME PERIOD 8                           **28 February 2001**  
Filing the record

ORDERPM5  
Revised October 1999  
(replaces ORDERPM4)

104,522  
cc (via First Class Mail):

Attorney for Nichols  
(real party in interest  
are the named inventors):

Kenneth M. Bush, Esq.  
Russell L. Sandidge, Esq.  
SIROTE & PERMUTT, P.C.  
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Tel: 205-930-5100  
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E-mail: kbush@sirote.com  
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Attorney for Tabakoff  
(real party in interest  
Lohocla Research Corporation):

Talivaldis Cepuritis, Esq.  
Dolores T. Kenney, Esq.  
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36th Floor  
Chicago, IL 60606

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E-mail: olsonhierl@aol.com

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**SIROTE & PERMUTT PC-BIRMINGHAM**  
2311 HIGHLAND AVE S. #500  
BIRMINGHAM, AL 35205

61-479/622  
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1-888-402-8160

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*[Signature]*

MP

DOCKET NO. 41766-1

SERIAL NO. 09/625,018

The date stamp of the Patent Office hereon may be considered as the date on which papers indicated below were received.

New Application	<input type="checkbox"/>	Notice of Appeal	<input type="checkbox"/>
Assignment	<input type="checkbox"/>	Appeal Brief	<input type="checkbox"/>
Drawing	<input type="checkbox"/>	Power of Att.	<input type="checkbox"/>
Resp. to O.A. <i>Notice to file paper</i>	<input checked="" type="checkbox"/>	Final Fee	<input type="checkbox"/>
Con. Doc.	<input type="checkbox"/>	Check	<input checked="" type="checkbox"/>

*Kerquest for Corrected filing receipt*

(Patent Office. Please stamp and return to addressee on reverse side.)